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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,130	08/30/2000	Kent Malmgren	010315-092	1064
21839	7590	02/03/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			CHANG, VICTOR S	
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ALEXANDRIA, VA 22313-1404			PAPER NUMBER	

1771

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/651,130

Applicant(s)

MALMGREN ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 11/3/2003. Applicants' amendments to claims 1 and 13-15, cancellation of claim 3, and newly added claims 16-20 have all been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 2, 4-15 and 20 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The liquid absorbing material is a polysaccharide or polypeptide foam is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

More particularly, claim 1 pertains to a liquid absorbing material comprises a polymeric foam material, whereas the Specification only discloses polysaccharide or polypeptide foam (species), which is not considered sufficient to represent a "material" or "polymeric foam material" as a genus per se. As such, the absence of

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polysaccharide or polypeptide foam as instant invention in the independent claim 1 renders the claimed invention unduly broad and in excess of its provided enablement. It should be noted that the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice ... by functional characteristics coupled with a known or disclosed correlation between function and structure ... sufficient to show the applicant was in possession of the claimed genus. If a representative number of adequately described species are not disclosed for a genus, the claim to that genus must be rejected as lacking adequate written description under 35 U.S.C. 112, first paragraph. See MPEP § 2163.IIA3(a)ii.

Additionally, the Examiner notes that since the property recitations in independent claims 1 and 13-15 purport to cover any conceivable polymeric foam materials either presently existing or which might be discovered in future and which would impart desired characteristics, but are unobvious to the instantly claimed invention, and the recitations also appear to read upon materials that could not possibly be used to form the contemplated genus or subgenus of articles, clearly the claims are unduly broad and in excess of the disclosure in the Specification. *Ex parte Slob* (PO BdApp) 157 USPQ 172.

6. Claims 1, 2, 4-15 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, substantially for the reasons set forth in section 4 of Paper No. 10, together with the following additional observations.

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For claims 1, 2, 3-15 and 20, the Examiner repeats that the property recitations merely setting forth physical characteristics desired in article, and not setting forth specific structure and compositions which would meet such characteristics are invalid as vague, indefinite, and functional, since it recites compounds by what it is desired that they do rather than what they are. As such, it is unclear as to what is the scope of the invention of which Applicant intends to claim. *Ex parte Slob* (PO BdApp) 157 USPQ 172. It should be noted that a claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be subject to rejection under 35 U.S.C. 112, first paragraph, as not enabling, or under 35 U.S.C. 112, second paragraph. See MPEP § 2163.I.B.

In claim 1, line 1, the newly added term "primarily" is vague and indefinite, because it is unclear just what is the scope (or range) of "primarily".

Additionally, it is noted that newly amended independent claims 1 and 13-15, lines 1-3 of each claim, now recite in part "primarily an open cell polymeric foam material, the foam material including a continuous three-dimensional network surrounding a gaseous phase dispersed therein". The Examiner suggests to delete the above underlined recitation, because it appears to be inherent and redundant to the earlier recitation "open cell foam".

Further, the Examiner notes that, at lines 3-4 of each independent claims 1 and 13-15, the recitation "the foam material being suitable for use as an absorbent structure" appears either redundant to the preamble, or rendering the claim indefinite, as it appears to redefine the instantly claimed invention, i.e., it is unclear just what is the

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instant invention, a "liquid absorbing material" or "foam material"? The Examiner suggests a rewrite to clarify the claimed invention. Similarly, the preambles in dependent claims require proper rewrites, so as to be consistent.

Finally, the Examiner notes that newly added claim 20 appears to be redundant to claim 13, as both claims having essentially the same structural elements. Redundant claim should be cancelled.

In addition, please correct any other informalities which may have been overlooked.

Response to Amendment

7. Claims 1, 2 and 4-20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chen et al. (US 6261679), substantially for the reasons set forth in sections 8-14 of Paper No. 10, together with the following additional observations.

Applicants' response arguing "In contrast to *Ex parte Slob*, the claimed material is clearly defined ..." (Remarks, page 7, bottom paragraph) has been carefully considered, but is not persuasive. The Examiner repeats that the claims in their present form are clearly unduly broad and in excess of the disclosure, also vague and indefinite and fails to give notice to one of ordinary skill in the art what type of the liquid absorbing material might infringe the instant invention, as set forth above.

With respect to Applicants' argument that "some of the embodiments of the present invention may consist of 100% foam, with no fiber" (Remarks, page 8, third full

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paragraph), the Examiner notes that such limitation is not recited in any of the claims, and also Applicants fail to provide any express support in the Specification.

With respect to Applicants' argument that "Although fibers may be present in some of the embodiments of the present invention, the fibers are only a minor part of the material, ..." (Remarks, page 9, first full paragraph), the Examiner notes that in Example 2, Run A, Chen discloses the weight ratio of egg white/Eucalyptus fiber (i.e., foam material/fiber) as 16/5 (g/g). As such, Chen's invention clearly reads on instantly claimed invention, Applicants' argument to the contrary notwithstanding.

With respect to Applicants' argument that "A fibrous network of the kind shown in Figure 2 of Chen will have a considerably lower CRC value than claimed ..." (Remarks, page 9, second full paragraph), the Examiner notes that Applicants fail to provide any evidentiary support or comparative study, and it is well settled that Attorney arguments cannot take the place of evidence.

For newly added claims 16-19, the Examiner notes that Chen's foam material of egg white is inherently a polypeptide.

For newly added claim 20, the Examiner notes that the instantly claimed first and second distribution of pores renders the structural elements of claim 20 to be redundant to claim 13, as set forth above. As to the amounts of liquid absorptions in each aforementioned distribution of pores, they are also believed to be either inherently disclosed by Chen, or an obvious optimization to one of ordinary skill in the art (see Paper No. 10, page 5). It should be noted that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by

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identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

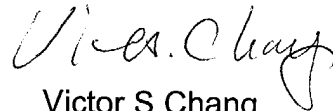
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0994.

A handwritten signature in cursive script, appearing to read "Victor S. Chang".

Victor S Chang
Examiner
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